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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,452	04/02/2004	Roger Minkow	019053.000112	1612
27644	7590	06/13/2005	EXAMINER	
THOMPSON & KNIGHT L.L.P. PATENT PROSECUTION DEPARTMENT 98 SAN JACINTO BLVD., SUITE 1900 AUSTIN, TX 78701			LUONG, VINH	
			ART UNIT	PAPER NUMBER
			3682	

DATE MAILED: 06/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/817,452

Applicant(s)

MINKOW ET AL.

Examiner

Vinh T. Luong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 16 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.


## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
Vinh T. Luong  
Primary Examiner

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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1. Applicant's election of Group I in the reply filed on May 26, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse. MPEP § 818.03(a).

2. Claims 16 and 17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on May 26, 2005.

3. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the

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printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

5. The abstract of the disclosure is objected to because the abstract: (a) should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art; (b) exceeds 150 words; and (c) uses the implied phrases such as "The invention" and "The inventive device." Correction is required. See MPEP § 608.01(b).

6. The drawings are objected to because:

(a) Each part of the invention, such as, the angle in claim 1 should be designated by a referential numeral or character; and

(b) The drawings are inconsistent with the claims and the specification. For example, claims 5 and 6 claim that the grip 10, 20 is made of rubber or plastic. However, Fig. 2 shows that the grip is made of metal in accordance with the drawing symbols for draftsman in MPEP 608.02.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

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application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

7. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed features, such as, the angle in claim 1, and the rubber, plastic, or chrome handgrip in claims 5-7 must be shown or the features canceled from the claims. *No new matter should be entered.*

8. The disclosure is objected to because of the following informalities:

(a) Each part of the invention, such as, the angle in claim 1 and paragraph [0036] of the specification should be designated by a referential numeral or character; and

(b) The drawings are inconsistent with the claims and the specification. For example, claims 5 and 6 claim that the grip 10, 20 is made of rubber or plastic. However, Fig. 2 shows that the grip is made of metal in accordance with the drawing symbols for draftsman in MPEP 608.02.

Appropriate correction is required.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-5, 8-12, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Heap (US Patent No. 6,261,141 B1).

Regarding claims 1, 8, and 15, Heap teaches a handgrip 12 or 14 comprising:

a generally tubular body having a horizontal midline 46 (Fig. 6);

a first tapered protrusion 28 (Fig. 3) disposed on a forward side of the generally tubular body, on which a person's fingers can rest; and

a second tapered protrusion 26 disposed on a rear side of the generally tubular body, on which the person's palm can rest;

wherein the first tapered protrusion 28 has a midline at an angle 50 (Fig. 6) to the horizontal midline 46; and

wherein the first tapered protrusion 28 and the second tapered protrusion 26 reduce ulnar neuropathy by relieving tension on the person's ulnar nerve.

Claim 1 and other claims below are anticipated by Heap because Heap teaches each and every positively claimed structure. It is well established that a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art teaches all the structural limitations of the claims. *Ex parte Masham*, 2 USPQ2d 1647 (BPAI 1987). Further, the functional limitations of a claim may not be given patentable weight where those limitations are inherent in a prior art reference. *In re Schreiber*, 44 USPQ2d 1429 (CAFC 1997). In addition, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152

USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Moreover, the “wherein” clause in the claims of this application merely expresses an inherent result or an intended use of the supporting mechanism, *a fortiori*, it adds nothing to claim’s patentability. *Texas Instruments, Inc. v. International Trade Commission*, 26 USPQ2d 1018 (CAFC 1993).

Regarding claims 2 and 9, the first tapered protrusion 28 is positioned for accommodating the person's second, third, fourth, and fifth fingers.

Regarding claims 3 and 10, the second tapered protrusion 26 is positioned for accommodating a portion of the person's palm that lies under the person's fourth finger and fifth finger.

Regarding claims 4 and 11, the generally tubular body includes a tapered recessed portion 32 (Fig. 3) for accommodating the person's thumb.

Regarding claims 5 and 12, the handgrip 12 or 14 is comprised of rubber as seen by drawing symbols for draftsman in Figs. 1A, 3, 4, and 6.

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claims 5-7 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heap in view of Roark et al. (USP 5,823,069).

Regarding claims 5-7 and 12-14, Heap teaches the handgrip substantially as claimed. However, Heap does not explicitly teach the well-known materials, such as, rubber, plastic, or chrome.

Roark teaches the use of well known materials, such as, rubber, plastic, or chrome in order to dampen vibration and improve frictional engagement with the handgrip. See Roark, col. 1, lines 25-37, and col. 3, lines 1-9. See also *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960) and MPEP 2144.07.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use of well known materials, such as, rubber, plastic, or chrome in order to dampen vibration and improve frictional engagement with Heap's handgrip as taught or suggested by Roark.

14. Claims 1, 8, and 15 are rejected under 35 U.S.C. 102(b) as being *clearly* anticipated by Johnson (Des. 248,616).

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Huang (Figs. 1-7), Ming-Chang (Figs. 1-6), and Lenhart (Fig. 1).

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday - Thursday.



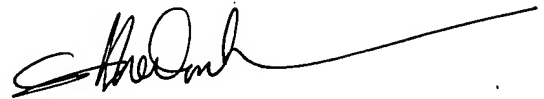
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci can be reached on 571-272-7099. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Luong

6/8/2005

A handwritten signature in black ink, appearing to read 'Vinh T. Luong', with a long horizontal line extending to the right.

Vinh T. Luong  
Primary Examiner